

REMARKS

Amendment to the Claims

Claim 18 has been amended to depend on claim 1. Support for the amendment can be found in the application as filed, for example, on page 11, final two lines, to page 12, line 10; and page 54, text lines 1-11. The amendment adds no new matter. Applicants respectfully request entry of the amendment.

Restriction Requirement

The Examiner requires an election between Group I, claims 1-17 and 19-27, characterized by the Examiner as drawn to amides of formula I and uses thereof, and Group II, claim 19, characterized by the Examiner as drawn to a drug for treating inflammatory processes.

The Examiner also asserted that the application contains two inventions or groups of inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1, and requires an election under 37 CFR 1.499. The Examiner asserted that the claim groups lack the same or corresponding technical features because, according to the Examiner, the compounds of formula I of Group I lack all the technical features of the drugs of Groups II which recite no structural formula. The Examiner also required election of a single species to which the claims shall be restricted if no generic claim is finally held to be allowable, and claims readable on the elected species.

Applicants provisionally elect Group I.

Applicants respectfully disagree with the Examiner and traverse the requirement for election among the claims defined as Group I and Group II. Applicants submit that the Examiner has not met the burden of establishing that the claims describe independent

and distinct inventions under 35 U.S.C. § 121. However, Applicants submit that the amendment of claim 18 to depend on claim 1 renders the Examiner's requirement moot for an election between the asserted claim groups. With this amendment, claim 18 now requires use of a compound of claim 1 in the treatment of the processes and conditions indicated in claim 18. Nevertheless, the Examiner has not addressed the fact that claim 1 includes compounds that would be useful as drugs in treating the processes and conditions described in claim 18. In this situation, the compounds of Group I would almost certainly be cross-referenced within the same classification as the drugs of Group II. The Examiner would almost certainly cite a reference related to the compounds of Group I against the drugs of Group II. Applicants submit that separate searches for each of the alleged classes would be substantially duplicative. Thus, Applicants submit that it would be reasonable to examine the asserted groups together and that the search would not present an undue burden on the Examiner.

With regard to PCT Rule 13.1, Applicants submit that the Examiner has not met the burden of establishing that the challenged claims are not so linked as to form a single general inventive concept. Applicants submit that the Examiner has not met the burden of establishing that the challenged claims lack a technical relationship involving one or more of the same or corresponding special technical features within the meaning of PCT Rule 13.2. Applicants submit that the challenged claims share technical features that define a contribution which each of the asserted claim groups, considered as a whole, make over the prior art. For example, the compounds of claim 1 can be used to treat the processes and conditions included in claim 18. Support for this statement can be found in the application as filed, for example, on page 11, final two lines, to page 12, line 10; and page 54, text lines 1-11. Thus, the challenged claims share technical features that define a contribution which both Group I and Group II make over the prior art. Accordingly, Applicants request reconsideration and withdrawal of the requirement for an election between Group I and Group II.

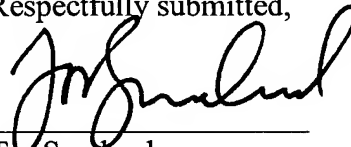
Applicants provisionally elect N – [2 – [(ethoxycarbonylmethyl)aminocarbonyl]oxyethyl] hexadecanamide, disclosed in Example 6 on pages 33-34 of the application as filed.

Applicants respectfully traverse the requirement of an election of a single species, for the reasons stated above. Accordingly, Applicants request reconsideration and withdrawal of the requirement for an election of a single species.

The Examiner also required a listing of claims readable on the provisionally elected species. Applicants submit that the following claims are readable on the provisionally elected species: claims 1, 4, 7, 8, 16-19, and 20.

No fee is required in connection with the filing of this Preliminary Amendment and Response to Restriction Requirement. If any fee is deemed necessary, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 11-0171.

Respectfully submitted,



Tor Smeland
Registration No.: 43,131
Attorney for Applicant

Kalow & Springut LLP
Telephone No.: (212) 813-1600